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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,236	07/24/2003	Michael Joseph Cassani	0333	1278
26868 7590 07/10/2008 HASSE & NESBITT LLC 8837 CHAPEL SQUARE DRIVE SUITE C CINCINNATI, OH 45249				
EXAMINER POINVIL, FRANTZY				
ART UNIT 3692		PAPER NUMBER		
MAIL DATE 07/10/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/626,236

**Applicant(s)**

CASSANI ET AL.

**Examiner**

Frantzy Poinvil

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/6/2007 have been fully considered but they are not persuasive.
2. Applicant's representative argues that the system of Shade is a three party system involving a gift recipient, a host and a charity whereas their claimed invention involves two parties and concludes that their system is different from the system of Shade.

In response, it should be noted that the prior invention was not based solely on Shade but on the combination of Shade, the Applicant's admitted prior art and Hartt et al (WO 94/04979). Furthermore, it is clearly noted that all the claimed functions are taught and/or found obvious in view of the noted combination and as indicated in the prior Office action.

3. Applicant's representative then states that “  
their present invention relates to methods and systems for operating  
and managing an investment fund in which charitable donations by the fund and/or its service  
providers are directed by the fund shareholders. Shareholders designate the charities that receive  
the contribution amounts, not a third party recipient as in Shade. As with other investment  
funds, individual investors purchase shares of the investment fund to achieve an investment  
return, and the fund and and/or its service providers assess fees on the assets of individual  
investors/shareholders. In the present invention, a charitable donation is included as a fee of the  
investment fund. Individual investors/shareholders of the fund direct the charitable donation fee

assessed on the value of their respective shares to a charity of their choice. The inclusion of the charitable donation fee as part of the normal operating fees assessed on an investment fund enables an individual to a) invest dollars in a financial instrument that provides an investment return for their own purpose, and b) support charitable causes. “.

In response, in the present invention, a plurality of functions are being recited with no indication of any of a specific party performing the claimed functions. Thus, as noted it is clearly shown that the combination of Shade, the applicant's admitted prior art and Hartt et al teaches and/or suggest the claimed invention as noted in the prior Office action. The argument that more than one party is involved in the system of Shade is not convincing because the applicant's claimed invention does not recite any distinction from the combined teachings which hints that specific party is performing any of the claimed functions.

4. The applicant's representative then summarizes the difference between Shade and their claimed invention as follow:

### **Shade**

<b>Gift Giver</b>	Designates gift amount and recipient
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<b>Gift Recipient</b>	Receives gift card and code and selects charity
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<b>Host</b>	Facilitates donation between giver, recipient and charity
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<b>Charity</b>	Receives donation
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## **Invention**

**Investor (shareholder)**      Invests principal into fund and designates charity

**Fund/Service Provider**      Assesses donation fee on assets within the fund, manages fund and receives fees for services; donates a portion of fees to designated charity; facilitates cash donation to charity

**Charity**      Receives cash donation

and stated that “In view of the above differences, the present invention would not have been obvious over Shade and the admitted prior art.

Regarding the Hartt reference, while it is known in the art to allow funds to be accumulated in an escrow account and then transferred to another account, Hartt does not disclose or suggest an investment fund in which a portion of the assessed fund fees are accrued and distributed in the form of a cash payment by the fund's administrator to charitable causes as directed by individual shareholders. Nor does Hartt disclose or suggest modifying Shade to provide the present invention. It is thus submitted that Claims 1-20 would not have been obvious over the cited references. “

In response, it is noted that the above noted differences detailed by the applicant is not recited in the claims. Particularly, the claims do not specifically recite: A fund/service provider

assesses donation fee on assets within a fund, manages fund, receives fees for services and donates a portion of fees to designated charity.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's arguments are not convincing.

It should be noted that the claims being now amended to recite the accumulated amounts are distributed in the form of a cash payment. As per this limitation, the combined teaching teaches distributing a charitable.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shade et al. (US Patent No. 6,519,573 in view of applicant's admitted prior art and Hart et al. (WO 94/04979).

As per claims 1-22, Shade et al disclose a system and method for an individual to access a host web site, select a charitable organization to make a donation. The host system then transmits the charitable gift to the gift recipient. See the abstract. Shade et al do not explicitly state the charitable gift being a plurality of securities. Providing different types of securities for

charitable purposes is old and well known in the art. The applicant's admitted prior art exemplifies this well-known type of charities. These types of charities use securities such as mutual funds, open-end funds, closed-end funds and other securities that are publicly listed and traded. See the applicant's admitted prior art or "Background of the Invention" section of the instant application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to also introduce different of types of mutual funds in the system of Shade et al in order to make the system more flexible by accepting a wide range of the different types of donations. Mutual funds or securities are usually managed by a fund manager, and the funds usually have an investment objective of investing based upon socially responsible criteria. See the applicant admitted prior art. The donor designates a contribution amount to his/her selected organization. The combination of Shade et al and the applicant's admitted prior art does not explicitly state "accumulating the contribution amounts for a designated period of time and distributing the accumulated contribution amounts to the designated charities.

Systems and methods for accumulating funds until an accumulated amount is reached for a later transferring of the accumulated funds to an account or entity is well practiced in the art. Hart et al disclose a system and method for allowing funds to be accumulated in an escrow account and then transferred to another account until it is reached a predetermined level. Applicant is directed to page 3, line 29 to page 4, line 13 of Hartt et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hart et al in the combination of Shade et al and the applicant's admitted prior art in order to allow a donor to make a monthly or weekly small donation that will not have a great financial burden on the donor.

Regarding the added language of distributing the contribution amounts in the form of cash as now recited in the independent claims, it should be noted that the claims being now amended to recite the accumulated amounts are distributed in the form of a cash payment. As per this limitation, the combined teaching teaches distributing a charitable.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/  
Primary Examiner  
Art Unit 3692**

FP  
February 6, 2008

**Application Number****Application/Control No.**

10/626,236

**Examiner**

Frantzy Poinvil

**Applicant(s)/Patent under  
Reexamination**

CASSANI ET AL.

**Art Unit**

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